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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005			EXAMINER DUBASKY, GIGI L	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/928,236

Applicant(s)

HARADA ET AL.

Examiner

GIGI L. DUBASKY

Art Unit

2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22 and 33-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22 and 33-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Claims 1-21, 23-32 and 41-42 have been cancelled.

Claims 22 and 33-40 are pending.

1. Applicant's arguments in the Remarks filed on 12/16/2009 have been considered but are moot in view of the new ground(s) of rejection.

Miscellaneous

The claim 22 recites the limitation of "**configured to**" in lines 27 and 28. The claim languages of "**adapted to**", "**adapted for**", "**configured for**", "**configured to**" and "**capable of**" may raise a question as to limiting effect of the language in a claim. This list of examples is not intended to be exhaustive. The subject matter of a properly construed claim is defined by the terms that limit its scope. The language, which suggests or makes optional but does not require steps to be performed or which does not limit a claim to a particular structure, is improper. See MPEP 2111.04.

Claim Objections

2. Claim 22 is objected to because of the following informalities: It appears to be a typo in line 21 for the word "acid". It should be amended to word "and". Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 22, 33 and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 5978013) in view of Nielsen (US 6002771).

Regarding claim 22, Jones discloses an information broadcast receiving terminal apparatus used in a broadcasting system including a center (see Figure 1 for a cable television distribution network as a "broadcasting system" includes elements 10, 12 and 14 located at a cable television station/head end as a "center" and subscriber unit 20 as an "information broadcast receiving terminal") and said information broadcasting receiving terminal apparatus comprising:
a receiving unit (TV tuner 76 and data tuner 100 in Figure 3 as "a receiving unit") for receiving contents data of services of each of various programs, service additional

information and coupon indirect information used to issue a coupon corresponding to one of the contents data of said services (Col 3 lines 12-15 and Col 4 lines 41-46 for transmitting multiple video signals (as various programs) each representing television programming such as entertainment, news and advertising (as contents data of service) from different sources over multiple television channels to the subscriber unit; Col 3 lines 3-31 for transmitting token/coupon identifier (as service additional information) and token/coupon information (as coupon information used to issue a coupon) over a data channel or over television channel by embedding them in the television signal and both television channel and data channel are received at the subscriber unit; and Col 3 lines 31-41 for generating a token/coupon using the retrieved token/coupon information only within the available window. It means that the information of coupon is indirect or incapable of use when it is not within available window),

said contents data and service information being broadcasted from the center as data of each of various programs (Col 3 lines 3-9 for transmitting token/coupon identifier and token/coupon information over a data channels or over television channel by embedding them in the television signal),

said contents data of services of each of various programs being made by the center, said contents data being configured with at least one of video information, sound information and character information, said at least one of video information, sound information and character information being transmitted by a broadcasting means (Col 2 lines 46-50 and 63-64 and Col 4 lines 60-65 for offering a coupon to the television viewer through a televised offer such as a product advertisement (content data of a

service of each various programs) represented by video signal (configuring data with video information) by embedding a coupon identifier in the video signals of advertising programming at the cable television station; Col 5 lines 2-8 for coupon identifier includes closed-captioned text of "COUPON AVAILABLE" (configuring data with character information), or has a verbally announcement of coupon available (configuring data with sound information),

said service additional information being made by the center (Col 2 lines 63-66 for embedding coupon identifier in the same manner as closed-captioning information into video signal representing the televised offer at the cable television station),

said coupon indirect information in the service additional information including said coupon, the coupon indirect information corresponding to a predetermined operation for allowing use of the coupon indirect information and being incapable of use alone for issuing said coupon (Col 3 lines 1-3 for token/coupon information as a coupon packet is either transmitted or pre-stored in a memory at the user's site; Col 3 lines 10-41 and Col 5 lines 10-49 for detecting embedded coupon identifier in video signal and using coupon identification number to retrieve a stored coupon packet (coupon indirect information) including coupon from a memory and in response to user's request to print a coupon within an available window (corresponding to a predetermined operation), generating a coupon using coupon information (allowing use of the coupon indirect information). It means that pre-stored coupon packet including coupon in a memory is incapable of use alone for issuing a coupon unless the user requests to print a coupon within an available window, the coupon information is retrieved and allowed to use to generate a

coupon);

a storing unit (RAM 228 in Figure 7) for storing said received contents data of services and service additional information apparatus (see Figure 8 and Col 14 lines 12-25 for storing received coupon identifier and coupon information into memory);

an information managing unit (processor 224 in Figure 7) for asynchronously managing said contents data of services and said service additional information stored in the storing unit (Col 14 lines 10-36 for managing coupon identifier, coupon information and additional information in the memory by the processor);

a regenerating unit for reading out at least one of said contents data of said services and said service additional information stored in said storing unit at an arbitrary timing so as to regenerate them (Col 7 line 54 through Col 8 line 2 for the subscriber unit functions both as a coupon generator and as a "converter box" to extract, decode and generate or regenerate received coupon identifiers and coupon information to provide a product coupon based on coupon information when a viewer views the television programs);

an accumulating unit for accumulating the received coupon indirect information (Col 14 lines 17-65 for managing and accumulating the received coupon identifier, coupon information in the memory by the processor); and

a decoding unit (coupon processor 138 in Figure 4 performs one of its functions as a decoding unit) configured not to decode said coupon indirect information without any performance of the predetermined operation corresponding to the coupon indirect information and configured to, upon performance of the predetermined operation

corresponding to the coupon indirect information, decode said coupon indirect information so as to issue the coupon which is capable of use (Col 11 line 36 through Col 12 line 38 for coupon processor 138 detects coupon identifier, reads and stores coupon identification number to form an address or pointer to read coupon information from a database, finds matched coupon information within the availability window field to notify the television user of coupon availability, upon receiving user's request to generate a coupon via a remote controller, retrieves, formats, reconstructs the coupon information corresponding to selected coupon identifier and provides it to a printer. It means that stored coupon information is decoded to issue a printed coupon which is capable of use only upon receiving user's request to print a coupon within an available window).

Jones does not explicitly disclose the coupon is encrypted by the sender and gets decrypted to be capable of use at the user site.

Nielsen discloses a system involving the use of discount coupons valid toward the repurchase of the merchandise (abstract), in which the discount coupons are encrypted by the vendor and sent to the user site (Col 3 lines 59-62 and Col 5 line 51 through Col 6 line 15) where the encrypted coupons are decrypted to be capable of use for repurchasing the merchandise (Col 3 lines 63-64 and Col 6 lines 16-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Jones' coupon information including encrypted coupon as taught by Nielsen, so to provide a robust system which enhances security of coupon delivery to authorized users.

Regarding claim 33, Jones in view of Nielsen discloses the apparatus as discussed in the rejection of claim 22. The combined system, Jones per se, further discloses the coupon indirect information includes at least one piece of information corresponding to at least one of the contents data of the services which can issue a coupon (Col 5 lines 2-11 for the coupon identifier includes a closed-captioned text of "COUPON AVAILABLE", a coupon identification number and a control code corresponding to advertised product), and when said at least one of the contents data of the services is regenerated so as to be displayed by the regeneration step in the information broadcast receiving terminal apparatus, in a case where the coupon indirect information corresponding to the at least one of the contents data of the services is accumulated (Col 10 lines 29-54 for displaying a single-digit LED or displaying currently stored coupon identification number on LCD display to represent number of coupons currently available to the television viewer), said decoding step decodes the coupon indirect information according regeneration operation on the basis of the one piece of information so as to notify of the coupon to said viewer (Col 8 lines 25-43 for decoding the ASCII-encoded string "COUPON AVAILABLE" of coupon identifier to display it on television to notify the viewer).

Regarding claim 35, Jones in view of Nielsen discloses the apparatus as discussed in the rejection of claim 22. The combined system, Jones per se, further discloses an arbitrary coupon code is given to the coupon (Col 5 lines 9-11 for including

a coupon identification number in the coupon identifier), and said decoding unit has a function for, when the coupon code is inputted, decoding the coupon indirect information by using the inputted coupon code so as to issue said coupon (Col 10 lines 54-66 and Col 12 lines 20-38).

Regarding claim 36, Jones in view of Nielsen discloses the apparatus as discussed in the rejection of claim 22. The combined system, Jones per se, further discloses a viewer information accumulating unit for accumulating information about the viewer, and a controlling unit for judging whether the coupon information is notified to the viewer or a coupon is issued on the basis of the viewer information (Col 9 lines 4-20 for notifying the viewer of coupon availability upon comparing the demographic information in received coupon packet to the demographic information from demographic ROM that storing information about type of site, number of persons at the site, their ages, sexes, their consumption habits (view record) and their interested classes of products (taste information), if they match).

Regarding claim 37, Jones in view of Nielsen discloses the apparatus as discussed in the rejection of claim 35. The combined system, Jones per se, further discloses a remote controller used to input the coupon code (element 22 in Figure 1).

Regarding claim 38, Jones in view of Nielsen discloses the apparatus as discussed in the rejection of claim 37. The combined system, Jones per se, further

discloses an identification number for identifying the viewer or a dealer is given to said remote controller (Col 11 lines 47-65 for using coupon identification number to retrieve coupon information which includes the advertiser' logo to identify an advertiser).

Regarding claim 39, Jones in view of Nielsen discloses the apparatus as discussed in the rejection of claim 38. The combined system, Jones per se, further discloses the decoding unit has a function for decrypting the identification number transmitted from the remote controller as the coupon code to issue the coupon , and a function for varying a subtraction value on the basis of the identification number, said subtraction value being subtracted when the coupon is used (Col 10 line 50 through Col 11 line 7).

Regarding claim 40, Jones in view of Nielsen discloses the apparatus as discussed in the rejection of claim 38. The combined system, Jones per se, further discloses the identification number is stored in an IC card (Col 2 line 59 through Col 3 line 9 for generating token/coupon having any suitable form where the token/coupon is a product coupon or a ticket or a "smart card" by using token identifier to retrieve token information including identifier number for advertiser of the advertised products).

5. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 5978013) in view of Nielsen (US 6002771) and further in view of Hashimoto et al (US 5931905).

Regarding claim 34, Jones in view of Nielsen discloses the apparatus as discussed in the rejection of claim 22. The combined system, Jones per se, further discloses the coupon indirect information includes at least one piece of information corresponding to the service which can issue a coupon (Col 5 lines 2-11 for the coupon identifier includes a closed-captioned text of "COUPON AVAILABLE", a coupon identification number and a control code corresponding to advertised product), and wherein when said content data of the service is regenerated so as to be displayed by the regeneration step in the information broadcast receiving terminal apparatus, in a case where the coupon indirect information corresponding to the content data of the direct mail service is accumulated (Col 10 lines 29-54 for displaying a single-digit LED or displaying currently stored coupon identification number on LCD display to represent number of coupons currently available to the television viewer), said decoding step decodes the coupon indirect information according to the regeneration operation on the basis of the one piece of information so as to notify information of the coupon to said viewer (Col 8 lines 25-43 for decoding the ASCII-encoded string "COUPON AVAILABLE" of coupon identifier to display it on television to notify the viewer).

The combined system does not explicitly disclose the services include a direct mail service broadcasted by the center.

Hashimoto discloses a TV mail system which besides being capable of receiving and displaying the broadcasting programs, provides a mail or direct mail service broadcasted by a mail server (see abstract).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combined system of Jones and Nielsen with the teaching of Hashimoto about providing direct mail service through a TV, so to provide an enhanced interactive system that enables to receive a direct mail service through a TV.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIGI L. DUBASKY whose telephone number is (571)270-5686. The examiner can normally be reached on Monday through Thursday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

GD